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Paper No. 16

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OFFICE OF PETITIONS

In re Application of
Lester Sussman
Application No. 09/781,698
Filed: February 13, 2001
Title: SYSTEM AND METHOD FOR A
COMPLETE AND CONVENIENT
SHOPPING EXPERIENCE

DECISION ON PETITION

This is in response to the second renewed petition under 37 CFR 1.181, filed August 16, 2006, to withdraw the holding of abandonment.

On February 5, 2004, the Office mailed a Notice of Non-Compliant Amendment, which set a one-month extendable period to reply. The application became abandoned on March 6, 2004, for failure to submit a timely response to the Notice. On April 20, 2004, the Office mailed a Notice of Abandonment.

In the present renewed petition, petitioner requests that the Office withdraw the holding of abandonment due to nonreceipt of the Notice of Non-Compliant Amendment and the Notice of Abandonment.

PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

A review of the record indicates no irregularity in the mailing of the Notices, and in the absence of any irregularity in the mailing, there is a strong presumption that the Notices were properly mailed to the address of record.

In support of the assertion of non-receipt, petitioner provided the Office with an explanation of his system for docketing and tracking communications from the USPTO. Additionally, petitioner submitted photocopies of envelopes from the USPTO on which petitioner noted actions required to respond to the Office actions. Lastly, petitioner provided printouts of his calendar for January through March of 2004 from the petitioner's Outlook software.

Petitioner expressed that these documents are confidential and requested that they would not be included as part of the public record. The Office notes that pursuant to MPEP 724.02,

Information which is considered by the party submitting the same to be either trade secret material or proprietary material, and any material subject to a protective order, must be clearly labeled as such and be filed in a sealed, clearly labeled, envelope or container. Each document or item must be clearly labeled as a "Trade Secret" document or item, a "Proprietary" document or item, or as an item or document "Subject To Protective Order." It is essential that the terms "Confidential," "Secret," and "Restricted" or "Restricted Data" not be used when marking these documents or items in order to avoid confusion with national security information documents which are marked with these terms (note also MPEP § 121). If the item or document is "Subject to Protective Order" the proceeding, including the tribunal, must be set forth on each document or item. Of course, the envelope or container, as well as each of the documents or items, must be labeled with complete identifying information for the file to which it is directed, including the Office or area to which the envelope or container is directed.

The envelope or container must be accompanied by a transmittal letter which also contains the same identifying information as the envelope or container. The transmittal letter must also state that the materials in the envelope or container are considered trade secrets or proprietary, or are subject to a protective order, and are being submitted for consideration under MPEP § 724. A petition under 37 CFR 1.58 and fee therefor (37 CFR 1.17(g)) to expunge the information, if found *not* to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent, should accompany the envelope or container.

Furthermore, pursuant to MPEP 724.05,

A petition under 37 CFR 1.59(b) to expunge information submitted under MPEP § 724.02, **or that should have been submitted under MPEP § 724.02 (as where proprietary information is submitted in an information disclosure statement but inadvertently not submitted in a sealed envelope as discussed in MPEP § 724.02)** will be entertained only if the petition fee (37 CFR 1.17(g)) is filed and the information has been found *not* to be important to a reasonable examiner in deciding on patentability. If the information is found to be important to a reasonable examiner in deciding on patentability, any petition to expunge the information will be denied. Any such petition to expunge information submitted under MPEP § 724.02 should be submitted at the time of filing the information under MPEP § 724.02 and directed to the Technology Center (TC) to which the application is assigned.

Such petition must contain:

(A) a clear identification of the information to be expunged without disclosure of the details thereof;

(B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;

(C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;

(D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information;

(E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b).

Any such petition to expunge should accompany the submission of the information and, in any event, must be submitted in sufficient time that it can be acted on prior to the mailing of a notice of allowability or a notice of abandonment for original and reissue applications, or prior to the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC) for reexamination proceedings. Timely submission of the petition is, accordingly, extremely important. If the petition does not accompany the information when it is initially submitted, the petition should be submitted while the application or reexamination is pending in the Technology Center (TC) and before it is transmitted to the Publishing Division. If a petition to expunge is not filed prior to the mailing of a notice of allowability or a notice of abandonment for original and reissue applications, or prior to the mailing of a NIRC for reexamination proceedings, any material then in the file will remain therein and be open to the public in accordance with 37 CFR 1.14. Accordingly, it is important that both the submission of any material under MPEP § 724.02 and the submission of any petition to expunge occur as early as possible during the examination process. The decision will be held in abeyance and be decided upon the close of prosecution on the merits.

Upon review of the evidence submitted in all of the petitions, petitioner has met the showing that petitioner did not receive the Notice of Non-Compliant Amendment. The petition under 37 CFR 1.181 is granted. No petition fee is required.

Technology Center Art Unit 3627 has been advised of this decision. The matter is being referred to the Technology Center's technical support staff for mailing of a Notice of Non-Compliant Amendment. The one-month extendable period for responding to the Notice of Non-Compliant Amendment will be set to run from the mailing date of the new Notice.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

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